



PATENT 717901.19  
EXPRESS MAIL EL493160927US

#3  
Petition  
Correspondence  
FEB 26 2002  
1/3/02  
3643

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In-re Application of: John Granville Burns )  
U. S. Patent Application Serial Number: 10/006,017 )  
U.S. Filing Date: December 4, 2001 )  
PCT No.: PCT/GB00/02134 )  
International Filing Date: June 2, 2000 )  
Priority Data: )  
U.K. Patent No. 9912909.0 Filed June 4, 1999 )  
U.K. Patent No. 0012882.7 Filed May 30, 2000 )  
For: PLAYING SURFACE SUBSTRATE, IN )  
PARTICULAR TURF MATS )  
Attorney Docket: 717901.19 )

Examiner: Unknown.

Group Art Unit: 3643

RECEIVED

FEB 26 2002

GROUP 3600

RECEIVED

FEB 22 2002

OFFICE OF PETITIONS

Assistant Commissioner for Patents  
Washington, D.C. 20231  
Attn: BOX DAC

PETITION FOR CORRECTION OF NATIONAL PHASE FILING  
STATUS FOR A PATENT APPLICATION UNDER 37 C.F.R. SECTION 1.182

INTRODUCTION:

Applicant respectfully petitions for correction to provide U.S. national phase application filing status for the Applicant's patent application (United States Patent Application Serial Number 10/006,017) based on the February 14, 2002 phone call to Ms. Riley, who works in Customer Service for Patent Technology Center 3600 at the United States Patent Office.

STATEMENT OF FACTS:

Upon failure to receive a Notice of Acceptance under 35 U.S.C. Section 371 and 37 C.F.R. Section 1.494 or 1.495, Applicant's Attorney, on February 14, 2002 contacted the United

States Patent Office to ascertain why this Document was not received. Applicant talked to Ms. Riley, who works in Patent Technology Center 3600. Upon Ms. Riley's review of her information associated with the listed Patent Application, Ms. Riley informed Applicant's Attorney that the above listed patent application was not a PCT national phase patent application. This patent application was a bypass continuation patent application since these two alternatives were the only possible alternatives due to the fact that this preliminary amendment was not an original patent application and there were no prior co-pending U.S. patent applications.

Applicant is hereby appealing this decision as to the status of Applicant's Patent Application. Applicant's submission was a preliminary amendment that, in the identifying heading on the front page was specifically **addressed to Box PCT at the United States Designated/Elected Office (DO/EO/US)**. The prior application number along with the examiner and group art unit is listed as "unknown." The PCT Number was listed as PCT/GB00/02134 and the International Filing Date was listed as June 2, 2000. Priority dates of May 30, 2000 and June 4, 1999 for two Patents filed in Great Britain were listed. **No priority claim was made to the PCT application** and the one (1) year period for claiming priority under the Paris Convention and 35 U.S.C. Section 119 **expired on June 4, 2000 and May 30, 2001, respectively.**

A standard patent application transmittal was inadvertently utilized. However, this transmittal requires "**requisite information**" involving prior applications if Applicant's Patent Application was to be a continuation application and no such information was provided.

POINTS TO BE REVIEWED:

1. When all items required under 35 U.S.C. 371 and 37 C.F.R. Sections 1.494 or 1.495 have been provided within the requisite time period, should the Applicant be unjustly deprived of national phase filing status based on a mere clerical error in utilizing a pre-printed form that merely operated to provide a listing of documents that were mailed together?
2. When there are only two possible types of patent applications that could have been filed, i.e., a bypass continuation application based on a PCT application and a national phase application based on a PCT application and there are two primary places to receive an indication

as to the status of this patent application, i.e., the transmittal document and the identifying heading on the preliminary amendment and both documents clearly negate the possibility of a bypass continuation application, should a bypass continuation application status be conveyed upon the Applicant's Patent Application when it is clearly contrary to the Applicant's intent and the Applicant has not provided the continuation data that is specifically mandated by the United States Patent Office?

3. Should the Applicant, who has filed a complete patent specification with appropriate payment within the requisite time period that fully comports with 35 U.S.C. Section 371, be completely barred from obtaining U.S. national phase filing status based on a mere clerical error, that only involves use of a pre-printed transmittal document, when the United States Patent Office allows for virtually every other type of error correction by petition (extendable to five (5) months under 37 C.F.R. Section 1.53(c)) including the filing of missing pages of a patent specification or figures to the drawings, where the Applicant is able to obtain the same initial filing date as a submission of a completely deficient patent application?
4. There is a pre-printed form for revival of an abandoned PCT National Phase Patent Application, which is attached as Appendix A. This allows people to obtain a national phase patent application when they do not file the patent application or pay the fee within the requisite time period with a mere statement that the delay was unintentional. It is respectfully believed that the Applicant, who has filed a complete patent application, without delay, and with an appropriate fee authorization should not be prohibited from obtaining a U.S. National phase patent application. If Applicant utilizes this petition to revive, then there will two patent applications with identical subject matter, which is directly prohibited under 35 U.S.C. Sections 121 and 101. Therefore, should an applicant who is completely dilatory in filing a national phase patent application have a superior ability to rectify the situation over an applicant who has filed a complete patent application within the requisite time period with a complete payment authorization?
5. Should the Applicant, because of his status as a foreign citizen, suffer an undue hardship and prejudice due to the loss of PCT national phase status? The Applicant will be required to

provide certified copies of Great Britain Patent No. 9912909.0 and Great Britain Patent No. 012882.7, which is very prejudicial against this foreign individual since a similar requirement is not required for a PCT national phase application since the certified copies of these U.K. Patents have already been filed. Also, it is not required of U.S. citizens regarding co-pending U.S. patent applications. There is also a separate PCT definition for unity of invention that is also more liberal than that found under United States Regulations so that by proceeding under U.S. Regulations will also pose a severe detrimental hardship to this Foreign Applicant.

ACTION REQUESTED:

Conversion of U.S. Application Patent Serial No. 10/006,017 to a U.S. national phase patent application of International Patent Application No. PCT/GB00/02134 is respectfully requested.

DISCUSSION:

Applicant filed the enclosed the Preliminary Amendment, which is hereby attached as Appendix B, which operates as a substitute specification and under 37 C.F.R. Section 1.125 can be filed at any time in U.S. national phase applications up to the point of issuance. This preliminary amendment is **specifically addressed to Box PCT, United States Designated/ Elected Office (DO/EO/US)**. Box PCT, under Official Gazette Notices dated February 5, 2002 is “**only for mail related to applications filed under the Patent Cooperation Treaty**” as shown in Appendix C. A bypass continuation patent application is not a PCT application but merely a U.S. patent application that claims priority to an International PCT Application. Therefore, since this was not a new international patent application, the only possible patent application that could have been filed based on this preliminary amendment was a PCT national phase patent application. It is respectfully believed that no bypass continuation patent applications have ever been filed at Box PCT, United States Designated/ Elected Office (DO/EO/US). The heading identification material also makes it clear that it is a PCT case that claims priority of two patent applications from Great Britain that were filed on May 30, 2000 and June 4, 1999, respectively. These were the **only references to priority**. Under 35 U.S.C. Section 119, as well as the Paris Convention, there is only a **twelve (12) month priority period** for a foreign patent application. This time period, at the very latest, **expired on May 30, 2001**. Therefore, these claims to

priority are totally meaningless if this is a bypass continuation patent application. The only way these priority claims make any sense whatsoever is by referring to the listed International Patent Application No. PCT/GB00/02134 that was filed on June 2, 2000 to ascertain the only real possibility, which is that this is a U.S. national phase patent application. Therefore, it is respectfully believed that a review of the heading identification material on the preliminary amendment that was addressed to Box PCT at the United States Designated/ Elected Office (DO/EO/US) and the claims of priority to patent applications that was filed more than twelve (12) months ago would demonstrate that there is no ambiguity, but only one possible conclusion, which is that this U.S. Patent Application Serial No. 10/006,017 is a U.S. national phase patent application.

The transmittal document that was utilized, attached as Appendix D, is merely the standard transmittal prescribed by the United States Patent Office that lists the attached documents and includes a fee sheet that allows payment of any additional fees. The use of this transmittal was a mere inadvertent clerical error. The fee sheet provides for payment of any additional fees to fully comport with 35 U.S.C. Section 371, 37 C.F.R. Section 1.494 and 37 C.F.R. Section 1.495. This transmittal document requires, in **Section 18**, that: “**If a CONTINUING APPPLICATION, check appropriate box, and supply the requisite** information below and in a preliminary amendment, or in an Application Data Sheet under 37 C.F.R. Section 1.76.” (emphasis added). The box for a continuing application was specifically not checked and continuing application data was specifically not provided. This data was deemed **required**, which is defined in *The New Lexicon Webster’s Dictionary*, p. 846 (1987), herein attached as Appendix E, as: “stipulated or demanded” “Stipulation” is defined as: “---a condition for reaching agreement.” *Id.* At 975, herein attached as Appendix F. Therefore, the absence of this necessary material makes it clear that a bypass continuation was not desired nor wanted. It is respectfully believed that Applicant should not obtain a bypass continuation when the necessary and requisite material mandated by the transmittal was not provided. Therefore, by not providing this material makes it very clear that it was a U.S. national phase patent application that was filed and not a bypass continuation patent application.

Therefore, both documents either viewed alone or together, on their face, eliminate all possible ambiguity and make it clear that a U.S. National Phase Patent Application was intended and any possible intent to file a bypass continuation application was clearly negated. In other

words, no bypass continuation applications are filed at Box PCT/ United States Designated/ Elected Office (DO/EO/US) and the **required** information regarding continuation data was not provided on the transmittal document.

Although the United States Patent Office has a special form for the transmittal of fees and documents for entering the U.S. national phase, the PCT Applicant's Guide – Volume II – Page 7, attached herein as Appendix G, specifically states that this “---form should preferably (**but need not**) be used.” (US.03, emphasis added). Therefore, the inadvertent use of the wrong transmittal document should not preclude Applicant from obtaining national phase patent application status.

The United States Patent Office provides correction of virtually every type of error and irregularity. This includes correction of inventorship, correction of a filing date, and so forth. The United States Patent Office even allows for filing of missing pages of a patent application and missing drawings at a later date, while providing the Applicant with the filing date of the few papers that were initially filed. This can be extended up to five months under 37 C.F.R. Section 1.53(c). In the alternative, the correct transmittal form for this patent application is hereby submitted as Appendix H. This is only one pre-printed form and should have much less significance than any page missing from a patent application. Applicant respectfully requests comparable treatment and consistency in U.S. Patent Office practice. The Commissioner is authorized to charge any additional fees needed to correct this error to the Applicant's Deposit Account No. 11-0160.

In addition, one of the five pre-printed forms that is available for an Applicant from the United States Patent Office for entering the U.S. national phase is a Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally under 37 C.F.R. Section 1.137(b), hereby enclosed as Appendix A. This allows an Applicant to have a U.S. national phase patent application even when the time limits are totally ignored and absolutely nothing is filed within the requisite time period. In this case, a full and complete patent application was filed with appropriate payment (fee and fee authorization) within the requisite time period that fully comports with 35 U.S.C. Section 371(c). Therefore, even if the Applicant files a petition of this nature and the petition is granted, then Applicant will have two pending patent applications that are absolutely identical. Under 35 U.S.C. Sections 101 and 121,

this is absolutely and totally **prohibited** by the United States Patent Office and the Courts as **double patenting**.

It is respectfully believed that there is no logical reason to allow an applicant, who is absolutely dilatory and does not file anything within the requisite time period set forth by the Patent Cooperation Treaty, to be able file a petition with a statement that the entire delay was unintentional and easily obtain a U.S. national phase patent application but deny an applicant national phase patent application status, who has fully complied with all aspects of 35 U.S.C. Section 371(c) by filing a complete patent application with an appropriate payment (fee and fee authorization) within the requisite time, simply due to the presence of an erroneous transmittal document. It is respectfully believed that this is particularly unreasonable when both the submitted transmittal document and the heading identification material from the preliminary amendment absolutely dictate a national phase patent application and not a bypass continuation patent application. It is respectfully believed that the administration of the laws related to patents by the United States Patent Office is fair and evenhanded. In view of this, since an applicant who is totally dilatory can obtain a U.S. national phase application then an applicant who fully complies with 35 U.S.C. Section 371(c) is most certainly entitled to a national phase patent application especially in view of a clear and unequivocal expression of this intent.

This Applicant is a foreign citizen, so that loss of U.S. national phase status will require a certified copy of Great Britain Patent No. 9911209.0 and a certified copy of Great Britain Patent No. 0012882.7, which operates as an extreme hardship and is very prejudicial against this foreign individual since a similar requirement is not required for the U.S. national phase patent application since copies of these Patents have already been filed with the PCT International Application PCT/GB00/02134. Also, it is not required of U.S. citizens with regard to co-pending patent applications that were filed in the United States. Moreover, the standard for unity of invention is much more liberal under the PCT Regulations than under U.S. Regulations, which could also provide a hardship for this Foreign Applicant. It is respectfully believed that constitutional issues are raised when similarly situated applicants are treated differently based on their country of origin.

CONCLUSION:

The undersigned respectfully submits that the present application should be corrected to obtain U.S. national phase filing status. Upon review of the preliminary amendment identification heading and the transmittal document, the Applicant clearly and unequivocally expressed his intent to have a U.S. national phase patent application. The preliminary amendment was addressed to Box PCT, United States Designated/Elected Office (DO/EO/US), which only accepts PCT patent applications and not U.S. bypass continuation patent applications. The priority data makes no sense since it would have expired under 35 U.S.C. Section 119 if the application was a bypass continuation application and not a U.S. national phase patent application. Even though a standard transmittal document was utilized, mandated and required continuation information was specifically not provided by the Applicant. Therefore, this transmittal document can only indicate a U.S. national phase patent application since it is the only other option besides the bypass continuation patent application for this preliminary amendment.

In the alternative, the United States Patent Office specifically allows for later submission of major portions of a patent application and still grants the applicant the filing date of the initial submission. In view of this, there is nothing under either 37 C.F.R. Section 1.53(c) or 37 C.F.R. Section 1.182 that precludes one of these omitted pages from being the transmittal document, especially since the transmittal document plays a very trivial role and does not define the scope of the patent protection like the missing pages from a patent specification or missing drawings. The recommended transmittal document, as filed-out for this Patent Application, is attached herein as Appendix H.

Also, since an applicant who completely ignores the filing deadline for a PCT application can file a petition that explains that the delay was unintentional and easily receives a U.S. national phase application should not be in a superior position to an applicant who has fully complied with 35 U.S.C. Section 371 by filing all requisite items within the requisite time period.

Moreover, the loss of U.S. national phase status for this Foreign Applicant will operate as an extreme hardship by requiring certified copies of foreign patent applications, which the Applicant has already provided as part of the international application process. It is also very prejudicial to this Applicant since similarly situated U.S. Applicants claiming priority from

copending U.S. patent applications are not under this same requirement. This also applies to the unity of invention standard, which is more liberal under the Patent Cooperation Treaty than under U.S. law and will operate to this Foreign Applicant's extreme prejudicial detriment.

Therefore, Applicant respectfully requests conversion of this patent application to a U.S. national phase patent application. Please charge the petition fee of \$130 as set forth in 37 C.F.R. Section 1.17(h) and any other charges necessitated by this petition to Account No. 11-0160. If a telephone conference would facilitate resolving any issue related to this petition, the undersigned attorney for Applicant would appreciate and welcome such a telephone conference. The attorney for Applicant may be contacted as provided below.

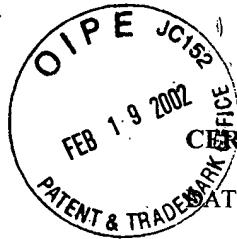
Respectfully submitted,

Dated: February 19, 2002



---

Kevin M. Kercher  
Registration No. 33,408  
Blackwell Sanders Peper Martin L.L.P.  
720 Olive Street, 24<sup>th</sup> Floor  
St. Louis, MO 63101  
(314) 345-6249  
Attorney for Applicant



02.21.02

**CERTIFICATE OF EXPRESS MAILING**

DATE OF DEPOSIT: February 19, 2002

EXPRESS MAIL NO: EL493160927US

I hereby certify that the foregoing Petition for Correction of National Phase Filing Status for a Patent Application under 37 C.F.R. Section 1.182 for U.S. Patent 10/006,017 (attorney docket no. 717901.19) and related documentation are being deposited with the United States Postal Service, Express Mail, postage prepaid, on the above-identified date, and is addressed to the Assistant Commissioner for Patents, **Box DAC**, Washington, D.C. 20231

Lori J. Dillon  
Lori J. Dillon

**RECEIVED**  
FEB 26 2002  
**GROUP 3600**

**RECEIVED**  
FEB 22 2002  
**OFFICE OF PETITIONS**

## **APPENDIX**

- Appendix A Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally under 37 C.F.R. Section 1.137(b)
- Appendix B Preliminary Amendment
- Appendix C Official Gazette Notices dated February 5, 2002
- Appendix D Transmittal Document
- Appendix E P. 846 of *The New Lexicon Webster's Dictionary* (1987)
- Appendix F P.975 of *The New Lexicon Webster's Dictionary* (1987)
- Appendix G Page 7 of PCT Applicant's Guide – Volume II
- Appendix H Correct Transmittal Form for this Patent Application